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IN THE

Supreme Court of the United States

October Term, 1967.

No. 249.

ANCHOR HOCKING GLASS CORPORATION,
Petitioner,

v.

CORNING GLASS WORKS.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Third Circuit.

PETITIONER'S REPLY MEMORANDUM.

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In compliance with the spirit of this Court's new Rule 24(4), which becomes effective on October 2, 1967, the present reply memorandum is "addressed to arguments first raised" in the brief in opposition, viz., the misstatements of fact and the omissions of fact in Corning's brief in opposition.

But it seems appropriate to note that we are seeking review in this case, not to expend the time of this Court for resolution of a factual patent controversy, but because the decision below has jettisoned and disregarded fundamental legal doctrines that were early formulated here, and that have been consistently enforced ever since in an effort to prevent patents from cloaking improper monopolies. Corning's brief in opposition avoids a forthright discussion of these legal doctrines by confining itself to non-existent factual issues which for the most part are contrary to the concurrent findings of the courts below.

Accordingly, we are filing this reply memorandum. We are briefly calling attention to the legal doctrines and applicable findings of facts on which our petition rests.

1. *File Wrapper Estoppel.* Corning's wholly argumentative "Statement of the Case" (Br. Op. 2-7) is notably silent concerning its own activity in the Patent Office. Contrariwise, we set out (Pet. 7-11) the application history of the patent in suit, showing in detail how this alleged "pioneer" invention was rejected four times in the Patent Office as unpatentable over the prior art, amended six times by Corning, supported by *ex parte* affidavits, and buttressed by four personal interviews with the examiner.

We showed further that Corning met the examiner's second rejection by employing the examiner's former but then retired superior, who recommended that all the claims should require the presence of at least 50% crystals to overcome the rejection (487b-491b). An amendment limiting all claims in this manner and urging that this limitation distinguished the claims from the prior art, was then prepared and filed (318b-329b; 324b, 325b, 327b).

That amendment was followed up by two steps, first by a meeting between Corning's patent solicitor, the examiner, and the examiner's former superior now acting as Corning's consultant (237b, 239b-240b), and second by a post-interview supplementary amendment in which Corning again stressed 50% crystallinity as the distinguishing feature between the claims and the prior art (330b-332b).

We pause to note that, notwithstanding the documented facts just set forth, Corning nonetheless insists that our original reference to the "personal intervention of a retired former immediate superior of the examiner" (Question 2, Pet. 2) is "wholly unsupported by the record" (Br. Op. 2).

We further pause to note that, in the face of our detailed citations at Pet. 8, Corning's further assertion (Br. Op. 5) that "Petitioner nowhere explains wherein the concrete claim limitation 'at least 50%' of crystals was, or is, required to distinguish from the prior art" is quite without foundation.

In short, without repeating what we have already documented in great detail at Pet. 7-11, it is the fact that the

application history of the present patent proves beyond possibility of factual contradiction what we have already argued (Pet. 14), namely

> "after Corning's application had been twice rejected as unpatentable over the prior art, it amended its claims to assert that the product was at least 50% crystalline, and it argued that this limitation distinguished its claims from the prior art cited by the examiner."

Once the patent was issued, however, Corning changed its tune; the limitation that was urged on the Patent Office as crucial was represented to the District Court as merely incidental; the inventor testified as a witness in court that the 50% limitation was unimportant (33b-34b, quoted in part by the court below, Pet. App. A9-A10).

The District Court held Corning to its Patent Office position (44a; 276b; Br. Op. B33), saying,

> "Even though the Patent Office did not require the 50% limitation in the patent, the patentee included this limitation and relied upon it to distinguish his patent from the prior art."

But the court below, ignoring Corning's Patent Office position and relying instead on its contrary post-Patent Office *pendente lite* position, said (Pet. App. A9) that "In interpreting the claims and specifications the District Court relied too heavily on the 50% crystallinity standard set forth in the patent."

Thus, very plainly, the District Court applied the doctrine of file wrapper estoppel, while the court below brushed it aside. Yet, as said in a case relied on by Corning (Br. Op. 2), *Smith v. Snow,* 294 U. S. 1, 14-15, "It is a familiar rule that a patentee cannot broaden his claim by dropping from it an element he was compelled to add in order to secure his patent." And only very recently this Court reiterated that well-established rule in *Graham v. John Deere Co.,* 383 U. S. 1, 33, saying "claims that have been

narrowed in order to obtain the issuance of a patent by distinguishing the prior art cannot be sustained to cover that which was previously by limitation eliminated from the patent."

Yet Corning now represents to this Court (Br. Op. 7) that "neither the District Court nor the Court of Appeals found any file wrapper estoppel in this case. No estoppel is spelled out by the history of the prosecution of the patent in suit, nor required by the prior art."

How Corning can make such assertions in the face of the voluminous materials that we have only very briefly summarized above is not for us to say.[1]

2. *Indefiniteness.* The District Court's holding that Corning's patent was void for indefiniteness because it failed to meet the requirements of 35 U. S. C. § 112 (quoted at Pet. 3)—see, for its findings in detail, 41a-46a; 273b-278b; Br. Op. B30-B35—is attacked by Corning with an argument that "as a pioneer patent it should be accorded a liberality of construction" (Br. Op. 2)—citing portions of decisions discussing the issue of infringement, not validity. It is strange indeed that Corning should rely on such inapposite decisions to support the novel legal principle upon which the decision of the court below must stand or fall—that 35 U. S. C. § 112 has two standards of definiteness for patent claims, the conventional one established by this Court and a new lower standard devised for the

1. Corning's further contention that our reference (Pet. 2, Question 2) to "Affidavits of questionable accuracy" is "wholly unsupported by the record" (Br. Op. 2) founders on the circumstances that the District Court adverted at length in its opinion to obvious ambiguities in and omissions from three of the affidavits (Witucki's, see 31a, 33a note 32; 263b, 265b note 32; Br. Op. B19, B20, B22 note 32; Klingsberg's and Kivlighn's, see 37a; 269b; Br. Op. B26); and it also pointed out that, in respect of one representation by Corning's patent solicitor, "Undoubtedly, this statement is false" (39a; 271b; Br. Op. B28).

On this record, therefore, our reference (Pet. 2) to "affidavits of questionable accuracy" errs if at all on the side of understatement.

first time by the court below for so-called "pioneer" patents (Pet. 13, 17-18).

There is no occasion at this juncture to repeat our demonstration, see Pet. 15-17, that the present Stookey patent does not fall within the "pioneer" category as defined by this Court. All that is necessary here is to point out that 35 U. S. C. § 112 is concerned, not with the infringement of valid claims, but with the invalidity of claims couched in vague and indefinite language.

Not only does Corning fail to cite a single decision to support the peculiar dual standard of definiteness injected into 35 U. S. C. § 112 by the court below, but all the decisions of this Court are squarely the other way (Pet. 17-18). Indeed, one of the authorities cited by Corning (Br. Op. 2) supports our position. See *Eibel Co. v. Paper Co.*, 261 U. S. 45, 65: "Indefiniteness is objectionable, because the patent does not disclose to the public how the discovery, if there is one, can be made useful, and how its infringement may be avoided."

As the District Court found (41a-46a; 273b-278b; Br. Op. B30-B35; see also quotation at Pet. 11-12, 18) it was not possible except by "costly and lengthy independent experimentation to ascertain" how its infringement may be avoided. Corning makes a broadside attack on those findings (Br. Op. 6); but the record shows and the District Court found that Corning's own scientists were unable (e.g., 73b-74b, 216b-217b, 486b, Pet. 11-12) to make the crystallinity measurements it now so airily asserts to have been easy. These scientists (including the patentee in suit) testified that it would take 50 years to measure the percent crystallinity of the patent examples alone and when two of them tried to measure the crystallinity of Anchor's accused product shortly before trial, one of them found this product contained 40% crystals whereas the other reported the *same* product contained 66% crystals (Pet. 12-13 note 4, giving detailed record references).

But there is no occasion now to marshal all the evidence in support of the District Court's findings, because the court below proceeded on the ground that "the District Court erred * * * since the standards placed upon this particular patent were, as a matter of law, too strict" (Pet. App. A6). Thus we are dealing with "a matter of law"—not a dispute of facts.

3. *Corning Ware.* Corning (Br. Op. 3) suggests that its CORNING WARE formulation "is very similar to and a refinement of patent example 1", but it never asserts squarely that the present patent created CORNING WARE—and indeed its admissions at trial destroy any such contentions. Its president conceded at trial that both the CORNING WARE formulation and its heat treatment rested on many later patents and other developments by a large group of individuals (A468-469b; A44-45b DX-7). And Dr. Stookey testified to the same effect (A5b; Trial Transcript 270-81, not printed).

The limitedless claims of this patent unquestionably embrace CORNING WARE—and numerous other products not yet discovered—but the patent fails to *teach* how to make any of these products. This patent is merely an invitation to experiment in a boundless and uncharted area, with the successful experiments pre-empted by Corning and the failures charged against the experimentors.

CONCLUSION.

The basic questions presented by this petition are two: First, whether the court below was justified in rejecting the doctrine of file wrapper estoppel, thus sanctifying the course of conduct whereby Corning after successfully persuading the Patent Office that the limitation of 50% crystallinity was important, to distinguish the claims from the prior art, immediately thereafter persuaded the court below—with equal success—that the limitation was unimportant. Second, whether 35 U. S. C. § 112 now has two stand-

ards of definiteness for patent claims, instead of the one established by this Court and consistently applied by lower courts until the decision below.

Together these two questions add up to a patent case of genuine public importance, because, if the decision below is permitted to stand, prospective patentees will be mightily encouraged to play fast and loose with the Patent Office. This is a particular danger when coupled, as here, with a further holding that expands the patent so that its limits become unclear—especially in an industry that in the past, as this Court's files bear witness, has been plagued with unconscionable restraints of trade imposed by economically powerful business units.

We accordingly believe that this is a case calling for review by this Court.

Respectfully submitted,

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